88-1356 (1)

No. _____

Supreme Court, U.S.
FILED
FEB 14 1989
JOSEPH F. SPANIOL, JR.
CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

TERM 1988 - 1989

JAMES N. CONSTANT,

Petitioner

v.

ADVANCED MICRO-DEVICES, INC., et al.,

Respondents *

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

James Constant
1603 Danbury Drive
Claremont, CA 91711
(714) 624-1801

Pro se petitioner

---

* see APPENDIX A for a complete list of all Respondents

QUESTIONS PRESENTED FOR REVIEW

1. Does the district court have jurisdiction to perform the Patent Office function under 35 USC 302 et seq. for the reexamination of petitioner's patents, based on references not considered by the Patent Office (distinct from references considered by the Patent Office).

2. Whether the reexamination of patents by a district court, based on references not considered by the Patent Office, is an administrative or executive act.

3. Should a party pay the high cost of a formal court trial when it informs the court that Congress by statute provides for a low cost procedure to resolve the matter.

4. Should a party pay the high cost of a special master to review technology when it informs the court that the special master admits not having qualifications in any technology.

5. Should a party pay the high cost of a special master when it informs the court before trial of its inability to pay the master's fees.

6. Whether a patent lawyer who admits lacking qualifications in any technology and who admits that he is not qualified to testify as a technical expert can be appointed as a special master expert and used to write technical reports and to give technical testimony to defeat a United States patent.

TABLE OF CONTENTS

	Page
OPINION BELOW	1
JURISDICTION	1
STATEMENT OF THE CASE	2
REASONS FOR GRANTING THE WRIT. .	3
CONCLUSION	12

TABLE OF AUTHORITIES

Cases	Pages
Constant v. Advanced Micro-Devices, Inc., 7 USPQ2d 1057 (Fed. Cir. 1988) . . .	2,5,9,11
Forbro Design Corp. v. Raytheon Co., 190 USPQ 49 (CA 1 1976).	9,11
Nyyssonen v. Bendix Corp., 342 F2d 531, 144 USPQ 555 (CA 1 1965)	9,11
B.F. Sturtevant Co. v. Massachusets Hair & Felt Co., 122 F2d 900, 51 USPQ 198, CA 1 1941, cert. den. 315 US 823, 52 USPQ 644, 1942	9,11
Statutes	
28 USC 1254(1)	1
35 USC 302 et seq.	passim
Federal Rules of Evidence	
Rule 702	9,11

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

The petitioner, James Constant, respectfully prays that a writ of certiorari issue to review the decision of the United States Court of Appeals for the Federal Circuit decided 11 October, 1988 attached as APPENDIX A.

OPINION BELOW

The Court of Appeals for the Federal Circuit issued its decision affirming the "Order Granting Defendant's Motion to Retax Costs and Denying Plaintiff's Motion to Dismiss and Disallow Costs and for Sanctions" of the United States District Court for the Central District of California attached as APPENDIX B.

JURISDICTION

The jurisdiction of this Court is invoked under 28 USC 1254(1).

STATEMENT OF THE CASE

Petitioner's two patents were found invalid by the district court on the basis of recommendations by a special master over petitioner's objections that the court lacked jurisdiction to perform the Patent Office function under 35 USC 302 et seq., that the special master was not technically qualified, and that petitioner was unable to assume payments for the master's fees. The court of appeals affirmed. Constant v. Advanced Micro-Devices, Inc. 7 USPQ2d 1057 (Fed. Cir. 1988).

Costs of the patent litigation were taxed against petitioner in the amount of $123,832 (App. B). The court of appeals affirmed the decision (App. A-1 through A-7) and denied petitioner's Petition for Rehearing (App. A-8) and Suggestion for Rehearing in Banc (App. A-9).

REASONS FOR GRANTING THE WRIT

Costs against the petitioner ($123,832) were taxed in abuse of discretion in view of the court's lack of jurisdiction to re-examine petitioner's patents on the basis of references not considered by the Patent Office, in view of the low cost procedure for the reexamination of patents in the Patent Office under 35 USC 302 et seq. ($1,770 for each patent), in view of the special master's admitted lack of qualifications in any technology (the master's fee amounts to $85,598 of the total), and in view of appellant's inability to pay the master's fee. The district court was informed about these matters before it appointed the special master to review the two patents in suit.

1. While the district court has the power to review the Patent Office acts of granting petitioner's patents based on the record and to review the reexamination of petitioner's patents under 35 USC 302 et seq., based on references that were considered by the Patent Office, it lacks the power to perform the Patent Office function under 35 USC 302 et seq. for the reexamination of petitioner's patents based on references not considered by the Patent Office. The decision therefore to invalidate petitioner's patents, based on references not considered by the Patent Office, is an administrative act not a judicial act. In the absence of a record in the Patent Office for references used by the district court to invalidate petitioner's patents, there is a clear absence of all jurisdiction to reexamine petitioner's patents.

In affirming the district court's decision to invalidate petitioner's patents, the court of appeals ruled that

"There is no legal authority for the view that the court must first determine that the prior art in the evaluation of obviousness is more pertinent than the prior art considered by the PTO". Constant, supra 1065

However, this opinion contravenes the purpose for enactment by Congress of 35 USC 302 et seq. which provides for a determination of issue. 35 USC 303.

The district court's taxing of costs against petitioner in light of its lack of jurisdiction to perform the Patent Office function under 35 USC 302 et seq. for the reexamination of petitioner's patents, on the basis of references not considered by the Patent Office, is an abuse of discretion.

2. The responsibility for the reexamination of patents based on new art has been committed by Congress to the Patent Office. 35 USC 302 et seq. A court only performs an administrative or executive act when it determines the validity of a patent based on references not consiby the Patent Office in granting petitioner's patents. Jurisdiction should not be granted for such exercising of discretion to perform the administrative or executive function of the Patent Office.

3. Petitioner recommended the low cost Patent Office procedure under 35 USC 302 et seq. to the district court and the respondednts opposed. See transcript for the hearing on 5 May, 1986 at page 9 line 9 through page 11 line 8 and page 13 lines 14-23; transcript appears as Exhibit B in petitioner's Motion to Dismiss Determination of Costs filed 1 April, 1988 (RDN 726) (RDN = Relevant Docket Number).

The district court's taxing of costs against petitioner in light of its knowledge of the low cost procedure in the Patent Office for the reexamination of patents amounts to an abuse of discretion.

4. The special master (R. Hillman), appointed by the district court over petitioner's objections, admitted that he was not qualified in any technology. See Exhibits in petitioner's Petition for Rehearing and Suggestion for Rehearing in Banc (hereinafter EXHIBITS). As shown in EXHIBITS, Hillman admits "I do not have expert qualifications in this or any other technology" and "I would not be qualified to testify as a technology expert". Yet Hillman did just that and Judge Wilson used Hillman's technical reports and testimony to invalidate petitioner's patents and to retax the master's fees against petitioner (app. B). At trial, the district court refused to allow petitioner's questions directed to the master's qualifications (RDN 693 4-30) and directed that the master's testimony be limited to

the technical questions. See transcript for hearing 30 March, 1987 p 9 lines 21-24.

The court of appeal's finding that "Hillman is very well qualified", Constant, supra 1061, is not supported by the evidence in EXHIBITS. Moreover, Hillman does not qualify as a technical expert under the Federal Rule of evidence 702 or under the case authorities. See Forbro Design Corp. v. Raytheon Co., 190 USPQ 49 (CA 1 1976) (a person lacking qualifications in the pertinent art for testifying what would or would not have been known to one of ordinary skill in the pertinent art, should not be allowed to express an opinion); Nyyssonen v. Bendix Corp., 342 F2d 531, 144 USPQ 555 (CA 1 1965)(citing B.F. Sturtevant Co. v. Massachussets Hair & Felt Co., 122 F2d 900, 51 USPQ 198, CA 1 1941, cert. den. 315 US 823, 52 USPQ 644, 1942)(A patent speaks to its art and what it says can be told in

complicated cases only by one skilled in the art).

The district court's taxing of costs against petitioner in light of its knowledge that the special master was not qualified in any technology amounts to an abuse of discretion.

5. Petitioner informed the district court that appointment of the special master would create financial hardship on him (one reason Congress enacted 35 USC 302 et seq.). See petitioner's Opposition to Defendant's Motion to Retax Costs filed 6 April, 1988 paragraphs 3-11 and Exhibits E,F,G,I (RDN 730); see petitioner's financial statement filed 15 July, 1986 (RDN 605).

The district court's taxing of costs against petitioner in light of its knowledge that petitioner was unable to pay the master's fee amounts to an abuse of discretion.

The Federal Circuit finding that "There is no legal authority for the view that the court must first determine that the prior art in the evaluation of obviousness is more pertinent than the prior art considered by the PTO", Constant, supra 1065, contravenes the purpose of 35 USC 302 et seq.

The Federal Circuit finding that "Hillman is very well qualified", Constant, supra is inopposite to the evidence in EXHIBITS, to Federal Rule of Evidence 702, and to the case authorities in Forbro, Nyyssonen, and Sturtevant, supra.

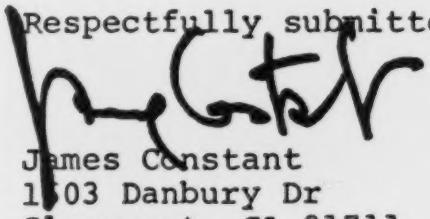
The petition should be granted because the court of appeals has so far sanctioned a departure from the usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

CONCLUSION

Because the district court lacks jurisdiction to perform the Patent Office function under 35 USC 302 et seq., for the reexamination of patents, based on references not considered by the Patent Office, because petitioner informed the court that the low cost procedure under 35 USC 302 et seq. was available to resolve matters, because the special master was not qualified in any technology, and because petitioner informed the court that he was unable to pay the master's fees, the costs against petitioner were taxed in abuse of discretion.

For the foregoing reasons, petitioner James Constant respectfully requests that a writ of certiorari issue to review the decision of the United States Court of Appeals for the Federal Circuit attached as APPENDIX A.

Respectfully submitted



James Constant
1503 Danbury Dr
Claremont, CA 91711
(714) 624-1801

pro se petitioner

14 February, 1989

A P P E N D I X A

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

88-1414

JAMES CONSTANT,

Plaintiff-Appellant,

v.

ADVANCED MICRO-DEVICES, INC.; GOULD, INC.; AMERICAN MICROSYSTEMS, INC.; ANALOG DEVICES, INC.; FUJITSU, LTD.; FUJITSU MICROELECTRONICS, INC.; DIGITAL SWITCH,INC.; GRANGER ASSOCIATES, INC.; HITACHI CORPORATION; INTEL, INC.; INTERACTIVE CIRCUITS & SYS LTD.; MATSUSHITA ELECTRONICS CORP.; COMPUTER MODULES, INC.; NIPPON ELECTRIC CO., LTD.; NEC ELECTRONICS USA; PARADYNE CORPORATION; SEMICONDUCTOR PRODUCTS; TEXAS INSTRUMENTS, INC.; and TRW, Inc.,

Defendants-Appellees.

DECIDED: October 11, 1988

Before SMITH, NIES, and NEWMAN, Circuit Judges. SMITH, Circuit Judge.

DECISION

James Constant (Constant) appeals the "Order Granting Defendant's Motion to Retax Costs and Denying Plaintiff's Motion to Dismiss and Disallow Costs and for Sanctions" of the United States District Court for the Central District of California in Constant v. Advanced Micro-Devices, Inc., No. 85-0262-SVW (C.D. Cal. filed May 10, 1988). We affirm.

OPINION

Constant mounts a 12-point attack on the district court's order. These 12 points, however, only provide us with 3 main issues: (1) whether the district court abused its discretion in refusing to recuse itself from presiding over the parties' motions; (2) whether the constitution prohibits a federal court from adjudicating the validity of a patent; and (3) whether the district court abused its discretion in its taxation of costs against Constant.

A. Failure to Recuse Was Not an Abuse of Discretion.

Constant urges to us that, because Judge Wilson was named by Constant as a defendant in a fraud suit relating to this case, Judge Wilson abused his discretion by not recusing himself from presiding over this proceeding. Constant, citing United States v. Sibla, 624 F2d 864 (9th Cir. 1980), contends that judges have a duty to recuse themselves if they become aware of grounds for recusal. We have no argument with the rule contended for; however, the record facts do not give rise to such a duty.

Under the law of the United States Court of Appeals for the Ninth Circuit, the law that controls our review of this issue, see Panduit Corp. v. All States Plastic Mfg. Co., 744 F2d 1564, 1575, 223 USPQ 465, 471 (Fed. Cir. 1984),

a judge need not recuse himself merely because a litigant sues or threatens to sue him. See United States v. Studley, 783 F2d 934, 940 (9th Cir. 1986); Ronwin v. State Bar of Arizona, 686 F2d 692, 701 (9th Cir. 1981). Here, as determined by Judge Wilson, the existence of the fraud suit did not provide grounds for recusal. Indeed, as subsequent events proved, the whole fraud proceeding, on appeal, was deemed frivolous. See Constant v. Wilson, No. 88-1195 (Fed. Cir. Aug. 25, 1988).

B. A District Court Is Not Constitutionally Precluded from Adjudicating the Validity of a Patent.

Constant contends both that the Constitution may prohibit a district court from performing the "Patent Office function under 35 USC 302 et seq. (distinct from reviewing acts of the Patent Office) and

that 35 USC 282 is unconstitutional. These contentions are a reworded version of the argument Constant presented to us in Constant v. Advanced Micro-Devices, Inc., 848 F2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988), that the Constitution prohibits a district court from adjudicating the validity of a patent. Because this argument already has been rejected by this court, id at 1563-65, 7 USPQ2d at 1058-60, we do not address it here.

C. The District Court Did Not Abuse Its Discretion in Awarding Costs.

With respect to the specific costs awarded by the district court to the appellees, Constant relies on the same arguments he made to the district court in response to appellee's motions for costs. The court below rejected these arguments and we cannot hold that it was an abuse of discretion to do so.

The appellees were the prevailing party in the patent infringement action brought by Constant and, as such, were entitled to costs, pursuant to the local rules of the district court. We cannot disturb that court's allowance of such costs unless we determine that it abused its discretion . See Syntex Opthalmics, Inc. v. Novicky, 795 F2d 983, 986, 230 USPQ 427, 430 (Fed. Cir. 1986). On the record before us, we discern no abuse of discretion.

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

88-1414

JAMES CONSTANT, Appellant,

v.

ADVANCED MICRO-DEVICES, INC. et als.

Appellees

ORDER

A petition for rehearing having been filed in this case. UPON CONSIDERATION THEREOF, it is ORDERED that the petition for rehearing be, and the same hereby is, denied. The suggestion for rehearing in banc is under consideration.

FOR THE COURT

11/22/88

Francis X. Gindhart
Clerk

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

88-1414

JAMES CONSTANT, Appellant

v.

ADVANCED MICRO-DEVICES, INC. et als.

Appellees.

ORDER

A suggestion for rehearing in banc having been filed in this case, UPON CONSIDERATION THEREOF, it is ORDERED that the suggestion for rehearing in banc be, and the same is declined.

FOR THE COURT

12/6/88

Francis X. Gindhart
Clerk

A P P E N D I X B

UNITED STATES DISTRICT COURT

FOR THE CENTRAL DISTRICT OF CALIFORNIA

CV 85 0262 SVW

JAMES CONSTANT,

Plaintiff,

v.

ADVANCED MICRO-DEVICES, INC., et al.,

Defendants

ORDER GRANTING DEFENDANT'S MOTION TO RETAX COSTS AND DENYING PLAINTIFF'S MOTION TO DISMISS AND DISALLOW COSTS AND FOR SANCTIONS

Defendant's motion to retax certain costs and plaintiff's motion to dismiss determination of costs, disallow costs and for sanctions against defendants came on for hearing before the United States District Court, Honorable Stephen V. Wilson presiding, on May 2, 1988 at 1:30 p.m., upon due notice. Defendant

Fujitsu Microelectronics, Inc. ("FMI") appeared through its counsel, Adrian M. Pruetz of Morrison & Foerster, and FMI represented the position of all defendants in this matter. Plaintiff James Constant appeared on his own behalf. The Court, having reviewed the memoranda, evidence and legal authorities filed in support of and in opposition to defendant's motion to retax certain costs and plaintiff's motion to dismiss and disallow costs and for sanctions, and having heard the arguments presented at the hearing;

IT IS HEREBY ORDERED:

1. Plaintiff's request that this Court recuse itself is DENIED.

2. Defendant's motion to retax the costs of the Special Master Robert Hillman and the costs of reproduction of specified documents against plaintiff is GRANTED, and plaintiff is ordered to pay defendant's

costs for those items in the amount of $95,289.71.

3. Plaintiff's motion to dismiss determination of costs, to disallow costs and for sanctions is DENIED, the costs taxed by the Clerk of the Court in the Bill of Costs are affirmed, and plaintiff is ordered to pay defendant's costs for those specified items in the amount of $28,542.29.

4. In accordance with the foregoing orders, costs in the total amount of $123,832.00 shall be entered into and made part of the Judgement entered in favor of defendants and against plaintiff on November 9, 1987, such costs to bear interest at the legal rate from date of entry, and such costs when recovered shall be payable to each defendant in the amount allowed.

DATED: May 10, 1988

STEPHEN V. WILSON

Honorable Stephen V. Wilson, United States District Judge

CERTIFICATE OF SERVICE

I certify that the foregoing PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT was served on all parties on 14 February, 1989 by mailing first class a true and correct copy thereof to them addressed as follows:

Edwin Taylor
Blakely, Sokoloff, Taylor & Zafman
1245 Oakmead Parkway, Suite 101
Sunnyvale, CA 94086

Attorneys for
INTEL CORPORATION

Joseph Golant
Romney, Golant, Marten & Ashen
10920 Wilshire Boulevard, Suite 1000
Los Angeles, California 90024

Attorneys for GOULD, INC. and AMERICAN MICROSYSTEMS, INC.

Robert Schroeder
Pretty, Schroeder, Brueggemann & Clark
444 South Flower Street, Suite 2000
Los Angeles, CA 90071

Attorneys for ANALOG DEVICES, INC. and NEC

NEC ELECTRONICS, INC.

Richard Fybel
Morrison & Foerster
333 South Grand Avenue, 38th Floor
Los Angeles, California 90071

Attorneys for FUJITSU MICROELECTRONICS, INC.

Howard Brody
Grossmann, Graven, Perry & Block
523 West 6th Street, Suite 1130
Los Angeles, California 90014-1109

Attorneys for DIGITAL SWITCH, INC. and GRANGER ASSOCIATES, INC.

Martin Horn
Spensley, Horn, Jubas & Lubitz
1880 Century Park East, Suite 500
Los Angeles, California 90067

Attorneys for HITACHI AMERICA, LTD.

Kristin Cano
Curtis & Vaccaro
Manufacturers Bank Building
One Newport Place, Suite 700
Newport Beach, California 92660

Attorneys for Paradyne Corporation

Paul Malingagio
Sheppard, Mullin, Richter & Hampton
333 South Hope Street, 48th Floor
Los Angeles, California 90071

Attorneys for TEXAS INSTRUMENTS, INC.

Allen Katz
Munger, Tolles & Rickershauser
355 South Grand Ave., 35th fl
Los Angeles, CA 90071

Attorneys for ROCKWELL INTERNATIONAL CORPORATION and TRW, INC. Lead Counsel

Anthony de Alcuaz
Skjerven, Morrill, MacPherson, Franklin & Friel
25 Metro Drive, Suite 700
San Jose, California 95110

Attorneys for ADVANCED MICRO-DEVICES, INC.

Solicitor General
Department of Justice
Washington, D.C. 20530

14 February, 1989

James Constant
1603 Danbury Dr
Claremont, CA 91711
(714) 624-1801

pro se petitioner

No. 88-1356 (2)

Supreme Court, U.S.
FILED
MAR 13 1989
JOSEPH F. SPANIOL, JR.
CLERK

IN THE

Supreme Court of the United States

October Term, 1988

JAMES CONSTANT,

Petitioner,

v.

ADVANCED MICRO-DEVICES, INC., GOULD, INC., AMERICAN MICROSYSTEMS, INC., ANALOG DEVICES, INC., FUJITSU, LTD., FUJITSU MICROELECTRONICS, INC., DIGITAL SWITCH, INC., GRANGER ASSOCIATES, INC., HITACHI CORPORATION, INTEL, INC., INTERACTIVE CIRCUITS & SYS. LTD., MATSHUSHITA ELECTRONICS CORP., COMPUTER MODULES, INC., NIPPON ELECTRIC CO., LTD., NEC ELECTRONICS USA, PARADYNE CORPORATION, SEMICONDUCTOR PRODUCTS, TEXAS INSTRUMENTS, INC., AND TRW, INC.,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITIONER'S PETITION FOR WRIT OF CERTIORARI

JOHN M. CALIMAFDE
HOPGOOD, CALIMAFDE, KALIL,
BLAUSTEIN & JUDLOWE
60 East 42nd Street
New York, New York 10165
(212) 986-2480
Attorneys for Respondents

Of Counsel:

MARVIN N. GORDON
HOPGOOD, CALIMAFDE, KALIL,
BLAUSTEIN & JUDLOWE
60 East 42nd Street
New York, New York 10165
(212) 986-2480

CRAIG S. SUMMERS
PRETTY, SCHROEDER,
BRUEGGEMANN & CLARK
444 South Flower Street
Suite 2000
Los Angeles, California 90071
(213) 489-4442

28pp

QUESTIONS PRESENTED FOR REVIEW

Respondents Analog Devices, Inc. and NEC Electronics Inc. (speaking on behalf of all respondents) present this statement of the Questions Presented For Review because respondents disagree that the petitioner James Constant has accurately formed the questions in the Petition for Writ of Certiorari (Petition").

1. May a Petition for Writ of Certiorari, having previously raised the same questions for review by this Court in the same action, and when this Court denied the petitioner's prior Petition for Writ of Certiorari on these issues, again petition this Court for a Writ of Certiorari to review the same issues previously submitted by petition for review by this Court?

2. Whether the United States District Court for the Central District of California abused its discretion in granting respondents' motion to tax certain costs against petitioner, and in denying petitioner s motion to disallow costs, and for sanctions against respondents.

3. Whether this Court should award respondents appropriate damages pursuant to Rule 49.2 of the Supreme Court based on the frivolous nature of the petition.

TABLE OF CONTENTS

	PAGE
QUESTIONS PRESENTED FOR REVIEW	i
TABLE OF CASES, STATUTES AND OTHER AUTHORITIES	iv
STATEMENT OF RELATED CASES	vii
OPINION BELOW	1
JURISDICTION	2
STATEMENT OF THE CASE	2
SUMMARY OF ARGUMENT	6
ARGUMENT	7
I. The Federal Circuit Correctly Found That The District Court Did Not Abuse Its Discretion In Refusing To Recuse Itself	7
II. The Federal Circuit Correctly Found That The District Court Did Not Abuse Its Discretion In Taxing The Costs Of This Action Against Petitioner	8
A. The Standard Of Review	8
B. Respondents Are The Prevailing Parties And As Such Are Entitled To Their Costs	8
C. Petitioner Made No Objection To Any Item On Respondents' Bill Of Costs Submitted To The Clerk Of The District Court	9
1. Reproduction Costs Were Properly Taxed Against Petitioner	10
2. Deposition Costs Were Properly Taxed Against Petitioner	10
3. The Special Master's Fees Were Properly Taxed Against Petitioner	11

PAGE

III. The Petition For Writ Of Certiorari Is Frivolous Within The Meaning Of Rule 49.2 Of This Court 13

CONCLUSION 14

TABLE OF CASES, STATUTES AND OTHER AUTHORITIES

PAGE

Cases:

Carpa, Inc. v. *Ward Foods, Inc.*, 567 F.2d 1316 (5th Cir. 1978) 12

Constant v. *Advanced Micro-Devices, Inc., et al.*, 848 F.2d 1560 (Fed. Cir. 1988) ..... 2 - 4

Criner v. *Micro-Westco, Inc.*, 3 F.R.D. 445 (S.D. Iowa) 10

Farmer v. *Arabian American Oil Company*, 379 U.S. 227 (1964) 8

Fressel v. *AT&T Technologies, Inc.*, 103 F.R.D. 111 (N.D. Ga. 1984) 10

Gary W. v. *State of Louisiana*, 601 F.2d 240 (5th Cir. 1974) 12

George R. Hall, Inc. v. *Superior Trucking Co.*, 532 F.Supp. 485 (N.D. Ga. 1982) 11

Hayes v. *Foodmaker, Inc.*, 634 F.2d 802 (5th Cir. 1981) 12

Hill v. *Duriron Co., Inc.*, 656 F.2d 1208 (6th Cir. 1981) 12

Hudson v. *Nabisco Brands, Inc.*, 758 F.2d 1237 (7th Cir. 1985) 11

Independence Tube Corp. v. *Copperweld Corp.*, 543 F.Supp. 706 (N.D. Ill. 1982) 10, 11

K-2 Ski Company v. *Head Ski Co., Inc.*, 506 F.2d 471 (9th Cir. 1974) 12

Panduit Corp. v. *All States Plastics Mfg. Co.*, 744 F.2d 1564 (Fed. Cir. 1984) 7

PAGE

Perlman v. *Feldmann*, 116 F.Supp. 102 (D. Conn. 1953) .. 9

Pickering v. *Holman*, 459 F.2d 403 (9th Cir. 1972) 8

Ronwin v. *State Bar of Arizona*, 686 F.2d 692 (9th Cir. 1981) 7

Schwarz v. *Folloder*, 767 F.2d 125 (5th Cir. 1985) 8

Spaulding v. *Univ. of Washington*, 740 F.2d 686 (9th Cir. 1983) 12

Sterner v. *Dept. of Army*, 711 F.2d 1563 (Fed. Cir. 1983) 9

Studiengesellschaft Kohle v. *Eastman Kodak Co.*, 713 F.2d 128 (5th Cir. 1983) 8

Syntek Opthalmics, Inc. v. *Novicky*, 795 F.2d 983 ..... 6, 8

United States v. *Studley*, 783 F.2d 934 (9th Cir. 1986) 7

W.F. & John Barnes Co. v. *Int'l Harvester Co.*, 145 F.2d 915, 919 (7th Cir. 1944) 10

Statutes:

28 U.S.C. Sec. 1254(1) 2

28 U.S.C. Sec. 1920(2) 11

28 U.S.C. Sec. 1920(4) 10

35 U.S.C. Sec. 102(b) 4

35 U.S.C. Sec. 103 4

35 U.S.C. Sec. 282 3

35 U.S.C. Sec. 302 ..... 2, 6, 12, 13

Supreme Court Rule 49.2 6

Fed.R.Civ.P. 53(a) 12

Fed.R.Civ.P. 54(d) 9

	PAGE
Local Rule 16.4.6	11
Local Rule 16.4.10	12
Local Rule 16.4.11	10
Local Rules 16.5 and 16.7	9
Treatises:	
C. Wright and A. Miller, Federal Practice and Procedure	12
J. Moore Federal Practice	12

STATEMENT OF RELATED CASES

United States Court of Appeals for the Federal Circuit

No. 88-1101
James Constant v. *Advanced Micro-Devices, Inc., et al.*

No. 88-1414
James Constant v. *Advanced Micro-Devices, Inc., et al.*

No. 88-1196
James Constant v. *Robert Hillman*

No. 88-1198
James Constant v. *Marcian Hoff, et al.*

No. 88-1197
James Constant v. *Hitachi America, Ltd., et al.*

No. 88-1195
James Constant v. *Stephen Wilson; Robert Hillman*

Supreme Court of the United States

No. 88-308
James Constant v. *Advanced Micro-Devices, Inc., et al.*

No. 88-1356

IN THE

Supreme Court of the United States

October Term, 1988

JAMES CONSTANT,

Petitioner,

v.

ADVANCED MICRO-DEVICES, INC., GOULD, INC., AMERICAN MICROSYSTEMS, INC., ANALOG DEVICES, INC., FUJITSU, LTD., FUJITSU MICROELECTRONICS, INC., DIGITAL SWITCH, INC., GRANGER ASSOCIATES, INC., HITACHI CORPORATION, INTEL, INC., INTERACTIVE CIRCUITS & SYS. LTD., MATSHUSHITA ELECTRONICS CORP., COMPUTER MODULES, INC., NIPPON ELECTRIC CO., LTD., NEC ELECTRONICS USA, PARADYNE CORPORATION, SEMICONDUCTOR PRODUCTS, TEXAS INSTRUMENTS, INC., AND TRW, INC.,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITIONER'S PETITION FOR WRIT OF CERTIORARI

OPINION BELOW

The Opinion of the United States Court of Appeals for the Federal Circuit from which petitioner seeks certiorari is not reported. A copy of that Opinion is attached hereto as Exhibit A.

JURISDICTION

The Judgment of the Court of Appeals was entered on October 11, 1988 (Petition A-2 to A-7). A petition for rehearing was denied on November 22, 1988 (Petition A-8). A suggestion for rehearing in banc filed by petitioner was declined on December 6, 1988 (Petition A-9). The petition for writ of certiorari was filed on February 14, 1989. The jurisdiction of this Court is invoked under 28 U.S.C. Section 1254(1).

STATEMENT OF THE CASE

Petitioner's Statement of the Case and Questions Presented for Review would make it appear that this is a new case raising questions not previously considered by the Court of Appeals for the Federal Circuit and by this Court. This is simply not true, since the same issues for which the petitioner here seeks certiorari were all previously decided on June 9, 1988 by the Court of Appeals for the Federal Circuit,[1] from which the same petitioner previously petitioned this Court for writ of certiorari. That petition was denied.[2]

As he did in his prior petition for writ of certiorari, petitioner seeks review by this Court of the jurisdiction of a district court to consider the validity of a patent, particularly in view of the reexamination procedure available in the U.S. Patent and Trademark Office pursuant to 35 USC Section 302 *et. seq.* (Petitioner's Questions 1, 2, and 3). Likewise, the petitioner again asks this Court to review the correctness of the district court's appointment of a Special Master (Petitioner's Questions 4, 5, and 6). Both of these issues were discussed at length by the Court of Appeals for the Federal Circuit in its June 9, 1988 opinion.

---

[1] *Constant* v. *Advanced Micro-Devices, Inc., et al.*, 848 F.2d 1560 (Fed. Cir. 1988).

[2] *James N. Constant, Petitioner* v. *Advanced Micro-Devices, Inc., et al.*, 102 L. Ed. 2d 218 (1989), 109 S Ct. 228 (1989).

Under the guise of a petition for review of the last decision of the Federal Circuit, which dealt solely with discretionary issues of taxation of costs and recusal, the petitioner incredibly attempts once again to gain review by this Court of the same questions decided by the Federal Circuit in its opinion of June 9, 1988, from which, as noted, this Court denied petitioner's earlier petition for writ of certiorari. In its latest (Oct. 11, 1988) opinion, the Federal Circuit noted that petitioner was again raising the argument that a district court was constitutionally prohibited from adjudicating the validity of a patent. The Federal Circuit stated "Because this argument has been rejected by this Court [898 F.2d] at 1563-65, 7 U.S.P.Q. 2d at 1058-60, we do not address it here."

The facts of the underlying action, of which this petition is hopefully the final stage, are now presented to assist this Court in assessing the merits of the present petition in its correct context.

In January, 1985, petitioner Constant filed a ten-count Complaint against seventeen defendants,[3] including the respondents herein, alleging infringement of United States Patent Nos. 3,950,635 (the ' "635 patent") and 4,438,491 (the ' "491 patent"). The Complaint also contained nine non-patent counts including challenges to the constitutionality of 35 U.S.C. Section 282 and federal funding of research and development. On motion of the defendants, the district court (Honorable Pamela A. Rymer) dismissed all counts with the exception of the single count that alleged patent infringement. The district court later denied numerous motions by petitioner Constant to revive the dismissed counts.

The defendants then filed counterclaims for declaratory relief pursuant to 35 U.S.C. Section 282, seeking to have the '635 and '491 patents declared invalid, unenforceable and non-infringed. The defendants then filed motions for summary judgment on

[3] All of the facts concerning the underlying action are set forth in detail in the Federal Circuit opinion in *Constant* v. *Advanced Micro-Devices, Inc., et al.*, 848 F.2d 1560 (Fed. Cir. 1988).

their counterclaims and Constant, in turn, filed motions for summary judgment on the issue of infringement. Thereafter, the case was transferred to the Honorable Steven V. Wilson for further proceedings.

With the agreement of *all* parties, Judge Wilson, in August, 1986 appointed a Special Master, Robert E. Hillman, to make recommendations to the district court on the issues of patent validity and infringement. Pursuant to the Order of Reference, the Special Master thereafter submitted his recommendations to Judge Wilson, which concluded that the patents were invalid. Only after the recommendation of invalidity of his patents was made to the district court did Constant move to disqualify the Special Master and strike his reports. The district court ruled against Constant's motions to disqualify and strike, after hearings at which Constant was given the opportunity to question the Special Master regarding the bases for his recommendation. The district court then independently determined that there were no material issues of contested facts and accordingly entered summary judgment declaring the claims of the '635 and 491 patents to be invalid under 35 U.S.C. Section 102 (b) and 35 U.S.C. Section 103.

Thereafter, on or about December 12, 1987, Constant filed an appeal in the United States Court of Appeals for the Federal Circuit, *Constant* v. *Advanced Micro Devices, Inc. et. al.*, Case No. 88-1101. On June 9, 1988, the United States Court of Appeals for the Federal Circuit affirmed the rulings of the district court in all respects. Specifically, the Federal Circuit affirmed the constitutional right of the district court to review the validity of issued patents and affirmed the district court's appointment of the Special Master.[4]

Following the entry of judgment by the district court, on November 24, 1987, respondents requested the clerk of the district court to tax the costs set forth in the Bill of Costs that they filed

[4] Reported at 848 F.2d 1560 (Fed. Cir. 1988). As noted *supra*, the petitioner's petition for writ of certiorari from that decision was denied.

jointly. On March 28, 1988, the clerk of the district court taxed costs against Constant in the amount of $29,320 for deposition costs, reproduction of exhibits, court-ordered service of plaintiff's pleadings and patent file materials. The clerk, however, disallowed costs for the fees respondents had paid to the Special Master, in the amount of $85,598.51, and also disallowed special reproduction costs in the amount of $9691.20 due to a policy of the clerk's office to leave taxation of such costs to the district court.

On April 1, 1988, respondents moved the district court to retax the fees of the Special Master and the reproduction costs to Constant. Concurrently, Constant moved the district court to dismiss determination of costs, disallow costs and impose sanctions against respondents. At a hearing on May 2, 1988, the district court granted respondents' motion to retax costs and denied Constant's motion. The district court ordered that the costs, totalling $123,832, be entered into and made part of the judgment entered in favor of respondents. This order granting respondents' motion to retax costs was entered on May 10, 1988.

Petitioner Constant filed a separate appeal to the Court of Appeals for the Federal Circuit from the May 10, 1988 district court decision regarding the issue of costs. On October 11, 1988, the Court of Appeals for the Federal Circuit issued its decision on petitioner's appeal (Exhibit A). The Federal Circuit affirmed the district court judge's refusal to remove himself from the case, and referred to its prior (June 9, 1988) opinion to reject petitioner's argument, raised here again, that the district court was constitutionally prohibited from reviewing the validity of patents.

The Federal Circuit then affirmed the district court's award of costs, noting that in his appeal, the petitioner relied "on the same arguments he made to the district court . . . " The Federal Circuit concluded by stating that the district "court below rejected these arguments and we cannot hold that it was an abuse of discretion to do so". The Federal Circuit then refused to disturb the district court's allowance of costs unless it could be deter-

mined that the district court had abused its discretion, citing *Syntex Opthalmics, Inc.* v. *Novicky*, 795 F.2d 983, 986 (Fed. Cir. 1986). The Federal Circuit concluded by observing that "[O]n the record before us, we discern no abuse of discretion".

The present petition for writ of certiorari ostensibly seeks review of this latest (October 11, 1988) Order of the Court of Appeals for the Federal Circuit. However, the six "Questions" raised by petitioner for review in this petition all relate to issues decided in the earlier decision of the Federal Circuit from which, as noted, petitioner's prior petition for writ of certiorari was denied by this Court. Namely, petitioner in Questions 1-3 seeks review of the district court's jurisdiction to review the validity of patents in view of the "low-cost" reexamination procedure in the Patent Office provided by 35 U.S.C. 302 *et seq.* Similarly, petitioner in Questions 4-6, questions the qualifications of the Special Master, which were also considered and decided in the prior opinion of the Federal Circuit from which this Court denied certiorari.

SUMMARY OF ARGUMENT

Petitioner has raised no new questions of review and, on this ground alone, the petition should be denied and declared frivolous pursuant to this Court's Rule 49.2, so that respondents be awarded their "appropriate damages". However, in perhaps an overabundance of caution we present here arguments similar to those submitted to the Federal Circuit, which ruled in its October 11, 1988 opinion that the district court had properly taxed costs of this action against petitioner, and that the district court had not abused its discretion in refusing to recuse itself. These issues, both of which are directed to the district court's discretion, raise no substantial questions of federal law, and are clearly not the proper subject of review by this Court. Nor is the October 11, 1988 decision of the Federal Circuit in conflict with the decision of any other Court of Appeals.

ARGUMENT

I. The Federal Circuit Correctly Found That The District Court Did Not Abuse Its Discretion In Refusing To Rescue Itself

Petitioner contended that Judge Wilson, the district court judge, should have recused himself because petitioner had previously brought suit against JudgeWilson in another case alleging fraud, which by then had been dismissed by the district court. That dismissal was subsequently affirmed by the Federal Circuit[5] which deemed the appeal "frivolous". As Judge Wilson noted, the law does not require that an action against a judge first be dismissed before recusal is no longer required. Rather, the law is well settled that a judge is not disqualified merely because a litigant sues or threatens to sue him or her. *Ronwin* v. *State Bar of Arizona*, 686 F.2d 692, 701 (9th Cir. 1981); *United States* v. *Studley*, 783 F.2d 934, 940 (9th Cir. 1986).[6] Nor is a judge disqualified by a litigant's intemperate and scurrilous attacks upon him or her. *Studley*, 783 F.2d at 940. As the Ninth Circuit Court of Appeals stated in *Ronwin*, "[s]uch an easy method for obtaining disqualification should not be encouraged or allowed." 686 F.2d at 701.

The Ninth Circuit has repeatedly held that the challenged judge should rule on the legal sufficiency of a recusal motion in the first instance. *Studley*, 783 F.2d at 940. Accordingly, Judge Wilson determined that he was not biased against petitioner, and that the mere fact that petitioner had chosen to complain against him due to dissatisfaction with a prior ruling was not a sufficient ground on which to base recusal. Judge Wilson's refusal to recuse himself, and the district court's (Judge William J. Rea) denial of Constant's motion to disqualify Judge Wilson were both entirely

---

[5] *James Constant* v. *Wilson, et al.*, No. 88-1195 (Fed. Cir. Aug. 25, 1988).

[6] Since this question did not relate to the patent laws, the Federal Circuit was bound by Ninth Circuit law. *Panduit Corp.* v. *All States Plastics Mfg. Co.*, 744 F.2d 1564, 1575 (Fed. Cir. 1984).

consistent with the facts and prevailing law, and were not an abuse of discretion.

II. The Federal Circuit Correctly Found That The District Court Did Not Abuse Its Discretion In Taxing The Costs Of This Action Against Petitioner

A. The Standard Of Review

A court's allowance of costs to the prevailing party in an action cannot be disturbed in the absence of an abuse of discretion. *Syntrex Ophthalmics, Inc.* v. *Novicky*, 795 F.2d 983, 986 (Fed. Cir. 1986), citing *Farmer* v. *Arabian American Oil Company*, 379 U.S. 227, 235, 85 S.Ct. 411, 416, 13 L.Ed.2d 248 (1964). Petitioner's arguments to the Federal Circuit objecting to the taxation of costs against him were found to be without merit. The Federal Circuit found that the district court had not abused its discretion in taxing the costs of this action against petitioner.

B. Respondents Are The Prevailing Parties In This Action And As Such Are Entitled To Recover Costs

In an order entered July 11, 1985, the district court dismissed with prejudice the nine non-patent counts in Constant's complaint. By its judgment entered on November 9, 1987, the district court terminated the final remaining claim in this action, for patent infringement, by finding petitioner's patents invalid. The respondents were thus the prevailing parties in the patent infringement action, and as such were entitled to their costs pursuant to the local rules of the district court.

The term "prevailing party" is applied by federal courts in the broad, practical sense, as the party who is more successful in the litigation as a whole. *Studiengesellschaft Kohle* v. *Eastman Kodak Co.*, 713 F.2d 128, 131-32 (5th Cir. 1983) (party does not have to prevail on every issue to receive costs; only be successful overall); *Schwarz* v. *Folloder*, 767 F.2d 125, 130-31 (5th Cir. 1985) (dismissal of plaintiff's claim with prejudice entitles defendant to costs); *Pickering* v. *Holman*, 459 F.2d 403, 407-08 (9th Cir. 1972)

(defendant in patent case entitled to costs when patent held invalid); *Sterner* v. *Dept. of Army*, 711 F.2d 1563, 1566-67 (Fed. Cir. 1983) (to be prevailing party, party need only have "substantially prevailed").

All of the non-patent claims in petitioner's complaint were dismissed with prejudice, and the patent claims were terminated by summary judgment holding the patents to be invalid. On these facts, and under the law, the Federal Circuit correctly found that respondents are the prevailing parties in this action.

C. Petitioner Made No Objection To Any Item On Respondents' Bill Of Costs Submitted To The Clerk Of The District Court

The Bill of Costs submitted by respondents to the clerk of the district court was accompanied by specific declarations of counsel and a memorandum of law setting forth the legal and factual authority for the requested costs. Petitioner made no specific objection to any item sought to be taxed as a cost. Since petitioner made no objection to any item on the Bill of Costs before the district court clerk, the district court need not have entertained petitioner's objections to these items on petitioner's appeal to it, and could properly have affirmed the costs taxed by the clerk on this ground alone. Fed.R.Civ.P. 54(d); District Court Local Rules 16.5 and 16.7; *Perlman* v. *Feldmann*, 116 F.Supp. 102, 111 (D. Conn. 1953). This rule also applies to the district court's granting of respondents' motion to retax certain costs, as petitioner made no specific objection to these items before the clerk. Nevertheless, in every instance, the district court's decision to tax costs against petitioner was well-grounded in both fact and law, and petitioner has never made any showing that the district court had abused its discretion. Petitioner merely argues that in view of the "lower cost" reexamination procedure available in the Patent Office these costs should not be taxed against him. This is both irrelevant and misleading. As the Federal Circuit affirmed, the district court had the complete authority to evaluate the validity of the

petitioner's patents, so that the availability of the Patent Office reexamination procedure had no bearing on the costs incurred by respondents in defending against the action that petitioner brought against them in the district court. Moreover, as noted below, it is petitioner who chose the federal courts rather than the Patent Office as the tribunal to evaluate his patents.

1. Reproduction Costs Were Properly Taxed Against Petitioner

Costs for exemplification and copies of papers necessarily obtained for use in the case are taxable against the losing party pursuant to 28 U.S.C. Section 1920(4). District Court Local Rule 16.4.11 further provides that costs for reproduction of documents may be recovered when such documents have been used as exhibits and/or evidence, are patent office documents, and/or are documents necessary to the case.

The district court did not abuse its discretion in following its local rules and allowing respondents' reproduction costs in the amount of $9,691 as incurred by lead counsel for respondents for the convenience and benefit of petitioner. Photocopying charges attributable to discovery and copies of pleadings, motions and memoranda are reasonably necessary for use in the case and can be awarded. *Independence Tube Corp.* v. *Copperweld Corp.*, 543 F.Supp. 706, 722 (N.D. Ill. 1982); *Fressel* v. *AT&T Technologies, Inc.*, 103 F.R.D. 111, 115-16 (N.D. Ga. 1984). The cost of photocopying patent file wrappers is recoverable under 28 U.S.C. §1920(4); *W.F. & John Barnes Co.* v. *Int'l Harvester Co.*, 145 F.2d 915, 919 (7th Cir. 1944), *cert. denied*, 324 U.S. 850 (1945); *Criner* v. *Micro-Westco, Inc.*, 3 F.R.D. 495, 496 (S.D. Iowa 1944).

2. Deposition Costs Were Properly Taxed Against Petitioner

The clerk of the district court also taxed the deposition costs incurred by respondents, and this was later affirmed by the district court. Costs incident to the taking of depositions are recov-

erable under 28 U.S.C. §1920(2), which provides that: "fees of the court reporter for all or any part of the stenographic transcript necessarily obtained for use in the case are taxable by the clerk of the court." Additionally, District Court Local Rule 16.4.6 specifically provides that the costs incurred in connection with the taking of depositions are taxable.

That the depositions taken of the petitioner by several of the respondents were reasonably necessary to them in the preparation of their defense, and in the prosecution of their counterclaims, is amply demonstrated by the extensive use of this deposition testimony in the respondents' oppositions to petitioner's numerous motions for summary judgment and in their successful motions for summary judgment declaring the petitioner's patents invalid. In *Syntex Ophthalmics, Inc.*, the Federal Circuit held that 28 U.S.C. §1920(2) expressly allows costs of transcripts "necessarily obtained for use in the case" not only for use "at trial". 795 F.2d at 986. Accord: *Hudson* v. *Nabisco Brands, Inc.*, 758 F.2d 1237, 1243 (7th Cir. 1985); *Independence Tube Corp.*, 543 F.Supp. at 718; *George R. Hall, Inc.* v. *Superior Trucking Co.*, 532 F.Supp. 985, 994 (N.D. Ga. 1982). The costs of deposition transcripts in the amount of $18,838.41 were thus properly taxed against petitioner under 28 U.S.C. § 1920(2), and District Court Local Rule 16.4.6. In taxing such costs against petitioner, the district court, as confirmed by the Federal Circuit, did not abuse its discretion.

3. The Special Master's Fees Were Properly Taxed Against Petitioner

Petitioner contests the taxing against him of the $85,598 fee paid to the Special Master, Hillman. Petitioner's basis for this contention is that Mr. Hillman allegedly lacked the necessary qualifications for the role of Special Master. Petitioner, however, ignores the fact that the issue of Mr. Hillman's qualifications to act as Special Master has already been completely resolved by the Federal Circuit in its Opinion of June 9, 1988, in which the Fed-

eral Circuit found that the district court had not abused its discretion in denying the petitioner's motion to disqualify the Special Master. In its decision, the Federal Circuit found that petitioner had agreed to the appointment of the master and participated in hearings and presentation of evidence to the master. It was only after the Special Master had issued recommendations unfavorable to the petitioner that he objected to the qualifications of the Special Master. A party cannot wait to see whether he likes a master's findings before challenging the master. Failure to object in a timely fashion constitutes a waiver. *Spaulding* v. *Univ. of Wash.*, 740 F.2d 686, 695 (9th Cir. 1984); *Hill* v. *Duriron Co.*, 656 F.2d 1208, 1213 (6th Cir. 1981); *Hayes* v. *Foodmaker, Inc.* 634 F.2d 802 (5th Cir. 1981).

Under Fed.R.Civ.P. 53(a), the compensation of a master is charged upon such of the parties as the court may direct. While the action was pending, the district court required the respondents to compensate the Special Master to ensure that payments to him be timely made. As a general rule, 'the prevailing party has the right to recover monies paid for the master as part of its recoverable costs for any portion it has paid . . . " 9 C. Wright and A. Miller, Federal Practice and Procedure §2608 at 798 (1971); 6 J. Moore, Federal Practice ¶54.77[3] at 1718 (2d. 1974); *K-2 Ski Company* v. *Head Ski Co. Inc.*, 506 F.2d 471, 476-77 (9th Cir. 1974). Accord: *Carpa, Inc.*v. *Ward Foods, Inc.*, 567 F.2d 1316, 1324 (5th Cir. 1978); *Gary W.* v. *State of Louisiana*, 601 F.2d 240, 245 (5th Cir. 1979). Additionally, District Court Local Rule 16.4.10 provides that reasonable fees and expenses of masters are taxable as costs.

Petitioner argues that he had recommended the "low-cost" patent procedure under 35 U.S.C. 302 *et. seq.* and the respondents opposed such a procedure. Petitioner is not accurate in his description and he ignores the fact that it was he who brought this action in the district court, not the respondents. Had he so de-

sired, the procedure of 35 U.S.C. 302[7] *et. seq.* was available to him, but he chose not to take advantage of it. The respondents were not obligated to follow petitioner's recommendation to take the matter to the Patent Office for reexamination. Petitioner, in any event, did not need the respondents' consent to that procedure. He did not, on his own, follow this path, and he cannot now complain that that decision not to seek Patent Office reexamination of his patents increased his costs. Moreover, as noted above, the petitioner did not object to the appointment of the Special Master until the master had ruled against him. Petitioner thus cannot now claim that it was an abuse of the district court's discretion to tax him for the master's fees, as the Federal Circuit has affirmed.

III. The Petition For Writ Of Certiorari Is Frivolous Within The Meaning Of Rule 49.2 Of This Court

The October 11, 1988 decision of the Federal Circuit from which the petitioner's writ is ostensibly taken deals with the narrow issues of whether the district court had abused its discretion in dealing with motions for recusal and for the taxing of costs. On both issues, the Federal Circuit held that there was no abuse of discretion by the district court. Petitioner ignores this decision, and instead petitions for a second time for a review by this Court of issues concerning the jurisdiction of the district court to determine the validity of U.S. patents and the district court's appointment of the Special Master. As noted, both of these issues were fully resolved by the Federal Circuit in its earlier decision, from which petitioner unsuccessfully sought review by writ of certiorari to this Court.

The present petition is thus an attempt to circumvent the proper procedure for seeking review by this Court, and is, in fact, an attempt to mislead this Court. It is at the very least frivolous,

---

[7] 35 U.S.C. §302. *Any person at any time* may file a request for reexamination by the [Patent] Office of any claim of a patent on the basis of any prior art . . . .[emphasis added].

warranting an award to respondents of their "appropriate damages" as called for in Rule 49.2 of this Court.

CONCLUSION

For the reasons set forth, the respondents submit that a writ of certiorari should not be granted in this case.

March , 1989

Respectfully submitted,

JOHN M. CALIMAFDE, ESQ.
HOPGOOD, CALIMAFDE, KALIL,
BLAUSTEIN & JUDLOWE
60 East 42nd Street
New York, New York 10165
(212) 986-2480

Of Counsel:

MARVIN N. GORDON, ESQ.
HOPGOOD, CALIMAFDE, KALIL,
BLAUSTEIN & JUDLOWE
60 East 42nd Street
New York, New York 10165
(212) 986-2480

CRAIG S. SUMMERS, ESQ.
PRETTY, SCHROEDER,
BRUEGGEMANN & CLARK
444 South Flower Street
Suite 2000
Los Angeles, California 90071
Tel.: (213) 489-4442

EXHIBIT A

EXHIBIT A

Note: This opinion has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

Nos. 88-1414

JAMES CONSTANT,

Plaintiff-Appellant,

v.

ADVANCED MICRO-DEVICES, INC.; GOULD, INC.; AMERICAN MICROSYSTEMS, INC.; ANALOG DEVICES, INC.; FUJITSU, LTD.; FUJITSU MICROELECTRONICS, INC.; DIGITAL SWITCH, INC.; GRANGER ASSOCIATES, INC.; HITACHI CORPORATION; INTEL, INC.; INTERACTIVE CIRCUITS & SYS LTD.; MATSHUSHITA ELECTRONICS CORP.; COMPUTER MODULES, INC.; NIPPON ELECTRIC CO., LTD.; NEC ELECTRONICS USA; PARADYNE CORPORATION; SEMICONDUCTOR PRODUCTS; TEXAS INSTRUMENTS, INC.; and TRW, INC.,

Defendants-Appellees.

DECIDED: October 11, 1988

Before SMITH, NIES, and NEWMAN, *Circuit Judges.*

SMITH, *Circuit Judge.*

DECISION

James Constant (Constant) appeals the "Order Granting Defendants' Motion to Retax Costs and Denying Plaintiff's Motion to Dismiss and Disallow Costs and for Sanctions" of the

United States District Court for the Central District of California in *Constant* v. *Advanced Micro-Devices, Inc.*, No. 85-0262-SVW (C.D. Cal. filed May 10, 1988). We *affirm*.

OPINION

Constant mounts a 12-point attack on the district court's order. These 12 points, however, only provide us with 3 main issues: (1) whether the district court abused its discretion in refusing to recuse itself from presiding over the parties' motions; (2) whether the constitution prohibits a federal court from adjudicating the validity of a patent; and (3) whether the district court abused its discretion in its taxation of costs against Constant.

A. Failure to Recuse Was Not an Abuse of Discretion.

Constant argues to us that, because Judge Wilson was named by Constant as a defendant in a fraud suit relating to this case, Judge Wilson abused his discretion by not recusing himself from presiding over this proceeding. Constant, citing *United States* v. *Sibla*, 624 F.2d 864 (9th Cir. 1980), contends that judges have a duty to recuse themselves if they become aware of grounds for recusal. We have no argument with the rule contended for; however, the record facts do not give rise to such duty.

Under the law of the United States Court of Appeals for the Ninth Circuit, the law that controls our review of this issue, *see Panduit Corp.* v. *All States Plastic Mfg. Co.*, 744 F.2d 1564, 1575, 223 USPQ 465, 471 (Fed. Cir. 1984), a judge need not recuse himself merely because a litigant sues or threatens to sue him. *See United States* v. *Studley*, 783 F.2d 934, 940 (9th Cir. 1986); *Ronwin* v. *State Bar of Arizona*, 686 F.2d 692, 701 (9th Cir. 1981). Here, as determined by Judge Wilson, the existence of the fraud suit did not provide grounds for recusal. Indeed, as subsequent events proved, the whole fraud proceeding, on appeal, was deemed frivolous. *See Constant* v. *Wilson*, No. 88-1195 (Fed. Cir. Aug. 25, 1988).

B. A District Court Is Not Constitutionally Precluded from Adjudicating the Validity of a Patent.

Constant contends both that the Constitution may prohibit a district court from performing the "Patent Office function under 35 USC 302 *et seq.* (distinct from reviewing acts of the Patent Office)" and that 35 U.S.C. §282 is unconstitutional. These contentions merely are a reworded version of the argument Constant presented to us in *Constant* v. *Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988), that the Constitution prohibits a district court from adjudicating the validity of a patent. Because this argument already has been rejected by this court, *id.* at 1563-65, 7 USPQ2d at 1058-60, we do not address it here.

C. The District Court Did Not Abuse Its Discretion in Awarding Costs.

With respect to the specific costs awarded by the district court to the appellees, Constant relies on the same arguments he made to the district court in response to appellees' motions for costs. The court below rejected these arguments and we cannot hold that it was an abuse of discretion to do so.

The appellees were the prevailing party in the patent infringement action brought by Constant and, as such, were entitled to costs, pursuant to the local rules of the district court. We cannot disturb that court's allowance of such costs unless we determine that it abused its discretion. *See Syntex Ophthalmics, Inc.* v. *Novicky*, 795 F.2d 983, 986, 230 USPQ 427, 430 (Fed. Cir. 1986) On the record before us, we discern no abuse of discretion.

PROOF OF SERVICE BY MAIL

On March 13, 1989, I served the Brief for Respondents in Opposition in re: BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITIONER'S PETITION FOR WRIT OF CERTIORARI; on the parties in said action, by placing three copies thereof enclosed in a sealed envelope with postage fully prepaid, in the United States post office New York, New York.

Mr. James Constant
1603 Danbury Drive
Claremont, California 91711

Edwin H. Taylor, Esq.
James C. Scheller, Jr., Esq.
Blakely, Sokoloff, Taylor
& Zafman
1245 Oakmead Parkway
Suite 101
Sunnyvale, California 94086

Philip P. Berelson, Esq.
Brown & Bain
600 Hansen Way
Suite 100
Palo Alto, California 93406

Paul S. Malingagio, Esq.
Sheppard, Mullin, Richter
& Hampton
333 South Hope Street
48th Floor
Los Angeles, California 90071

David M. Simon, Esq.
Spensley, Horn, Jubas
& Lubitz
1800 Century Park East
Suite 500
Los Angeles, California 90067

Howard P. Brody, Esq.
Grossman, Graven, Perry
& Block
523 West Sixth Street
Suite 1130
Los Angeles, California 90014

Anthony de Alcuaz, Esq.
Susan E. Hollander, Esq.
Skjerven, Morrill, MacPherson,
Franklin & Friel
3600 Pruneridge, Suite 100
Santa Clara, California 95051

Joseph H. Golant, Esq.
Thomas D. Phillips, Esq.
Romney, Golant, Martin
& Ashen
10920 Wilshire Boulevard
Suite 1000
Los Angeles, California 90024

Jerry R. Selinger, Esq.
500 LTV Center
2001 Ross Avenue
Dallas, Texas 75201-2916

Allen M. Katz, Esq.
Jeffrey I. Weinberger, Esq.
Munger, Tolles & Olson
355 So. Flower Street-5th Fl.
Los Angeles, California

Kristin M. Cano, Esq.
One Newport Plaza
Suite 550
Newport Beach, California

Joseph C. Sullivan, Esq.
Kane, Dalsimer, Kane &
Sullivan & Kurucz
711 Third Avenue
New York, New York 10017

Solicitor General of the United
States
10th & Constitution Ave. NW
Washington, D.C. 20001

Michael T. McLemore, Esq.
Arnold, White & Durkee
2300 American Center
600 Congress Avenue
Austin, Texas 78701

Richard D. Fybel
Adrian M. Pruetz
Morrison & Foerster
333 So. Grand Avenue-38th Fl.
Los Angeles, California 90071

Karl A. Limbach
Gerald T. Sekimura
Limbach, Limbach & Sutton
2001 Ferry Building
San Francisco, CA 94111

I certify under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Dated: March 13, 1989

Marvin N. Gordon